



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*APP*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/070,699    04/30/98    DICKENSHEETS    D    A-62591-3/AJ

MM12/0826

JANET E MULLER  
FLEHR HOHBACH TEST ALBRITTON & HERBERT  
SUITE 3400  
FOUR EMBARCADERO CENTER  
SAN FRANCISCO CA 94111-4187

EXAMINER

PHAN, J

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

08/26/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/070,699**

Applicant(s)  
**Dickensheets et al**

Examiner  
**James Phan**

Group Art Unit  
**2872**



☒ Responsive to communication(s) filed on 5/12/99 and 6/9/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 44-72 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 44-72 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2872

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a proper antecedent basis for the claimed subject matter in each of claims 44-72 should be provided.

The following rejection is based on the applicants' assumption that "a single substrate body" or "a first substrate body" is the silicon spacer 14 and "a second substrate body" is the silica lens plate 16 of Figure 3 at the upside down position.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 45, 49-52, 54-72 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the original disclosure is there a support for (1) the beam steering assembly is placed/disposed within the upper cavity (claims 45 and 55), (2) the primary optical element is provided within the V-groove (claim 49), (3) the features recited in claims 50-52 and 54, (4) a hinge for flexibly connecting the beam steering assembly with an upper

Art Unit: 2872

edge of the cavity (claim 55), (5) a suspended bridge spanning the primary optical path at a juncture between the primary optical path and the upper cavity (claim 56) (6) the frame is connected to the upper surface of the substrate body (claims 59, 63 and 66), and (7) a beam steering assembly rigidly affixed in a predetermined orientation within at least a portion of the upper cavity (claim 70).

3. Claims 44-72 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. To partially support for the claimed invention applicants have assumed that the scanning optical microscope is at an upside down position. However, nowhere in the original disclosure is there a teaching or suggestion that the disclosed scanning optical microscope is operable at the upside down position.

4. Claims 59-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "towards one surface" in claims 59, 63 and 66, at the last three terms, is indefinite since it is not clear what surface applicants referring to. Claims 60-62, 64-65 and 67-69 are also rejected in that they are dependent on the indefinite claims and thus inherit the deficiency above.

Art Unit: 2872

***Conclusion***

In the remarks of supplementary amendment filed 6/9/99 applicants stated that the examiner agreed that all the claims in the application would be allowable if claims 44 and 56 were amended as set forth above. The examiner disagrees. The applicants are directed to the agreement stated in the interview summary (paper no. 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Phan whose telephone number is (703) 308-4810. The examiner can normally be reached on M-F from 9:30 to 6:00. The fax phone number for this Group is (703) 308-7722.

Phan, J.

August 24, 1999

  
James Phan  
Primary Examiner